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REMARKS

This is a full and timely response to the non-final Official Action mailed January 9, 2008 (the "Action" or "Office Action."). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous Restriction Requirement, claims 16-21, 26-28 and 34-46 were withdrawn from consideration and cancelled without prejudice or disclaimer. Additionally, claims 15, 31-33, 47 and 48 have been cancelled without prejudice or disclaimer.

By the forgoing amendment, various claims have been amended and claims 3, 29, 30 and 57 were cancelled without prejudice or disclaimer. No new claims have been added.

Thus, claims 1, 2, 4-14, 22-25, and 49-56 are currently pending for further action.

Allowable Subject Matter:

The recent Office Action indicated that claims 3, 9, 10, 12-14 and 54-57 contain allowable subject matter. Applicant wishes to thank the Examiner for this finding of allowable subject matter.

Accordingly, Applicant has herein proposed to:

- (1) amend claim 1 to include all the recitations of allowable claim 3;
- (2) amend claim 4 to include all the recitations of allowable claim 57; and
- (3) amend allowable claims 54, 55 and 56, rewriting each as an independent claim including all the recitations of former base claim, claim 4.

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Therefore, upon entry of the present amendment, claims 1, 2, 4-14 and 49-56 would be in clear condition for allowance based on the allowable subject matter identified by the Examiner.

Amendment under 35 U.S.C. § 1.116:

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment makes only those changes necessary to place the application in better condition for allowance or appeal. The proposed amendments merely place the majority of the claims in condition for allowance based on indications by the Examiner. The amendment does not introduce any new claim language or raise new issues requiring further search or consideration. Therefore, entry of the present amendment is proper under 37 C.F.R. § 1.116 and is hereby requested.

Objection to Claims:

The recent Office Action objects to claims 30 and 57. This objection is moot in view of the cancellation herein of those claims.

Prior Art:

Claims 1, 2, 4, 5, 9-10 and 22-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,738,903 to Haines ("Haines"). This rejection is rendered moot except as to claims 22-25 by the proposed amendment herein based on the allowable subject matter identified by the Examiner.

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Referring to claims 22-25, claim 22 recites:

A consumable for use with a printing device, said consumable comprising:  
a printing device consumable;  
a memory coupled to said printing device consumable storing an identification key for identifying said printing device consumable with respect to said printing device; and  
a locking mechanism on said printing device consumable that renders said printing device consumable unusable until disengaged in response to verification based on said identification key.

Applicant notes that claim 22 recites "a consumable" and a locking mechanism "on said printing device consumable that renders said printing device consumable unusable." It is significant that claim 22 recites that the locking mechanism is on the consumable and renders the consumable itself unusable until disengaged. This subject matter is not taught or suggested by the cited prior art.

Haines does not teach or suggest the claimed consumable that includes the claimed locking mechanism that operates on the consumable itself. Haines appears to be directly only to teachings regarding a printing device. Moreover, the final Office Action does not indicate how or where Haines teaches this subject matter of claim 22.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Haines of claim 22 and its dependent claims should be reconsidered and withdrawn.

Claims 1, 2, 4-8, 11, 22-25, 49 and 50 were rejected under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 5,807,005 to Wright ("Wright") and U.S. Patent App.

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Pub. No. 2002/0077979 to Nagata ("Nagata"). This rejection is rendered moot except as to claims 22-25 by the proposed amendment herein based on the allowable subject matter identified by the Examiner,

As noted above, claim 22 recites:

A consumable for use with a printing device, said consumable comprising:  
a printing device consumable;  
a memory coupled to said printing device consumable storing an identification key for identifying said printing device consumable with respect to said printing device; and  
a locking mechanism on said printing device consumable that renders said printing device consumable unusable until disengaged in response to verification based on said identification key.

In applying Wright and Nagata, the final Office Action argues that the teachings of Wright read "on a locking mechanism that, when locked, disables either the printing device consumable or the printing device." (Action, p. 6). However, the Action cites no support in Wright for this position. To the contrary, Wright appears only to teach "[disabling] operation of the [print] engine if the cartridge class code does not match the machine class code in the cartridge support registry data table." (Wright, abstract). Nowhere does Wright teach or suggest the claimed locking mechanism that is on, and operates on, the consumable itself as opposed to the printing device.

Thus, Wright and Nagata considered together do not appear to teach or suggest the subject matter actually recited in claim 22. Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Wright and Nagata, did not include the claimed consumable including a locking mechanism on that consumable that renders the

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printing device consumable unusable until disengaged. This subject matter is outside the scope and content of the cited prior art. Consequently, the cited prior art will not support a rejection of claim 22 under 35 U.S.C. § 103 and *Graham*.

Finally, claims 1, 2, 4-8, 11, 22-25, 29 and 30 were rejected under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,081,850 to Garney ("Garney") and U.S. Patent No. 6,529,691 to Guy ("Guy"). This rejection is rendered moot except as to claims 22-25 by the proposed amendment herein based on the allowable subject matter identified by the Examiner.

As noted above, claim 22 recites:

A consumable for use with a printing device, said consumable comprising:  
a printing device consumable;  
a memory coupled to said printing device consumable storing an identification key for identifying said printing device consumable with respect to said printing device; and  
a locking mechanism on said printing device consumable that renders said printing device consumable unusable until disengaged in response to verification based on said identification key.

In contrast, as demonstrated above, the cited prior art does not teach or suggest a consumable for use with a printing device that includes "a locking mechanism on said printing device *consumable* that renders said printing device *consumable* unusable until disengaged in response to verification based on said identification key." (Emphasis added).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Garney and Guy, did not include a printing device consumable that includes

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"a locking mechanism *on said printing device consumable* that renders said printing device consumable unusable until disengaged in response to verification based on said identification key." (Emphasis added). This subject matter appears to be entirely beyond the scope and content of the cited prior art.

These differences between the cited prior art and the claimed subject matter are significant because the claimed consumable provides a means for preventing unverified printing device consumables from being unlocked for use in a printing device. Such a printing device consumable and its advantages were unrecognized and unknown in the cited prior art. Consequently, Garney and Guy will not support a rejection of claim 22 under 35 U.S.C. § 103(a) and *Graham*. Therefore, the rejection of claims 22-25 should be reconsidered and withdrawn.

Conclusion:

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.


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If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: March 6, 2008


  
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